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REMARKS

Claims 1-25 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1-25 Under 35 U.S.C. §103(a)

Claims 1-25 stand rejected under 35 U.S.C. §103(a) as being obvious over Hays *et al.* (US Patent 6,260,004) or Wang *et al.* (US Patent 5,566,092), either in view of Emori *et al.* (US Patent 5,940,272) and Lakin *et al.* (US Patent 4,840,222). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons.

The cited references, alone or in combination, do not teach or suggest applicant's claimed invention, let alone there being no motivation to combine the references as suggested other than *via* employment of applicant's specification as a 20/20 hind-sight based road map to achieve the purported combination.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, *the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on the Applicant's disclosure. See In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).*

As conceded by the Examiner, neither Wang *et al.* nor Hays *et al.* teach or suggest mounting monitoring electronics on industrial equipment - much less in the claimed manner.) Despite the lack of teaching of applicant's invention in the cited references let alone even motivation to modify the references in the manner suggested, the Examiner

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rejects the subject claims. In general, the rationale proffered to combine the references and/or modify the references is to achieve benefits identified in applicant's specification, which overcome problems associated with conventional systems/methods. Applicant's representative respectfully submits that this is an unacceptable and improper basis for a rejection under 35 U.S.C. §103. In essence, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in applicant's specification. This sort of rationale has been condemned by the CAFC. *See, for example, Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987). It is noted that even if the references are combined, applicant's claimed invention does not result.

Independent claim 1 recites "a machine diagnostic module [...] *mounted* to an *outer mounting surface* of the machine[...]." Mounting of the machine diagnostic module in the manner of the claimed invention provides for advantages over conventional machine diagnostic systems, such as the cited art. In particular, the diagnostic module is permanently fixed in a manner such that data can be reliably collected from a *same precise location*, whereby accurate comparisons can be made. (See specification at page 11, last paragraph - continued into page 12 first paragraph.) Typically, such data is collected at different times from the dynamoelectric machine and compared for ascertaining a trend, as well as, health of the dynamoelectric machine. The creditableness of such trend analysis rests in the ability to reproduce the *precise* location of the data sensed. Independent claims 23 and 24 also recited aspects of the subject invention regarding a diagnostic module that is fixed to a *mounting surface* of a machine.

In addition, independent claim 1 further recites "a heat dissipation device positioned *between* a container and an outer mounting surface of the machine. The positioning of the heat dissipation device between the contained and mounting surface of the machine provides for dissipating heat generated by the machine from adversely affecting sensitive components within the container. Such claimed features of the present invention are not taught or suggested by Emori *et al.* Rather, the heat radiating fins of Emori *et al.* functions as a *casing for surrounding* electric parts that create heat and electromagnetic interference. The fins of Emori *et al.* (in addition to having a very

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different structural arrangement from applicant's claimed invention) provide for removing heat from the components that generate the heat as compared to applicant's invention which protects electronic components from machine generated heat. (See Emori *et al.*, at col. 10, lines 23-26.)

Similarly, independent claims 23 further recites "a container to contain the diagnostic module [...] a heat dissipation device which includes a first set of fins [...] having a base which *engages an outer mounting surface of the machine* [...]" Independent claim 24 recites similar limitations. Such claimed features of applicant's invention are not taught or suggested by Emori *et al.*. Rather, Emori *et al.* teaches a plurality of fins that are part of the casing, which in turn partially *surround* heat generating components. (See Emori *et al.*, Fig. 1.)

Moreover, there is no motivation to combine the references in the manner suggested. The Office Action asserts that it is *well known*; to make integral that which was separate, to monitor operations of machines, to employ fins as being devices of cooling, and the like. Such reasoning has been consistently criticized by the Federal Courts;

... 'virtually all [inventions] are combinations of old elements.' Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'
In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) (citations omitted).

In view of the at least above, it is readily apparent that Wang *et al.*, Hays *et al.* and Emori *et al.*, alone or in combination do not teach or suggest applicant's claimed invention as recited in independent claims 1 (and dependent claims 2-22, 25), 23, and 24.

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In addition, *Lakin et al.* does not make up for the aforementioned deficiencies of *Wang et al.*, *Hays et al.* and *Emori et al.*, and this rejection should be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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